

Remarks

Reconsideration of this Application is respectfully requested.

Status of the Claims an the Application

The present Amendment and Reply is in response to the first Office Action on the merits of the claims following the Decision on Appeal issued March 27, 2007, in the subject application.

Upon entry of the foregoing amendments, claims 1-13, 23-27, and 29 are pending in the application, with claims 1, 6, 7, 9-13, 23, 26, 27, and 29 being the independent claims. Claims 14-22, previously withdrawn from consideration in the present application pursuant to a Restriction Requirement, are cancelled herein without prejudice to, or disclaimer of, the subject matter recited therein. Independent claim 28 also is cancelled herein without prejudice to, or disclaimer of, the subject matter recited therein. Claims 1-13, 23-27, and 29 are amended herein. No new matter has been added.

Summary of the Office Action

In the Office Action, the prior Restriction Requirement was made final, claims 12, 13, 28, and 29 were identified by the Examiner as containing language allegedly not mentioned in the specification (hereafter "objected to"), such that there allegedly is insufficient antecedent basis for the language in the claims, and claims 1-13 and 23-29 were rejected under the first paragraph of 35 U.S.C. § 112, as allegedly failing to comply with the written description requirement.

Reconsideration and withdrawal of the 'objection' and rejection respectfully are requested in view of the above amendments and the following remarks.

Summary of Examiner Interview

Applicants' attorneys gratefully acknowledge the courtesies extended to them by the Examiner in granting a telephone interview on March 23, 2009. In that interview, Applicants' attorneys requested clarification of the objection and rejection set forth in the Office Action. With respect to the objection to certain language in claims 12, 13, 28, and 29, the Examiner stated that the claims were not formally rejected on this stated basis. In this regard, Applicants' attorneys noted, and the Examiner acknowledged, that claims 12 and 13 do not include any of the language listed in the Examiner's objection; accordingly, the Examiner withdrew the objection with respect to these claims. Applicants' attorneys also asserted, and the Examiner acknowledged, that the language "means for" presented in accordance with proper means-plus-function format under the sixth paragraph of 35 U.S.C. § 112 corresponds to the particular structure(s) disclosed in the specification that performs the claimed function(s), and equivalents of such structure(s), and that the language "means for" is not required to be present in the specification for such language to be supported in such claim(s); accordingly, the Examiner withdrew the objection with respect to the listed "means for ..." terms. Applicants' attorneys also proposed for discussion a number of exemplary amendments to the specification, including language supported *in haec verba* in the original specification (including the original claims) of original parent Application No. 09/337,035 (incorporated by reference in the present application, and now U.S. Patent No. 6,671,718), and amendments to the claims deleting certain language objected to by the Examiner also in favor of language supported *in haec verba* in the specification (including the original claims) of original parent Application No. 09/337,035, to obviate the objection and the rejection set forth in the Office Action. The Examiner stated that if the proposed amendments conform to

the subject matter presented in the claims originally filed in the 09/337,035 application, and if the remarks in reply to the Office Action reference that the descriptive passages to be added to the present specification are supported in the original 09/337,035 application (including the original claims), then the Examiner would be inclined enter the amendments to the specification.

Amendments to the Specification

Applicants respectfully request that the specification be amended to include subject matter explicitly recited in the original specification (including the original claims) of original parent Application No. 09/337,035 (previously incorporated herein by reference in the present application, and now U.S. Patent No. 6,671,718), as discussed in the Examiner interview. The amendments to the specification include substantially the same subject matter as recited in original claims 1/6, 13, 14 and 22, as discussed below. Portions of these original claims particularly relied upon for various amendments to the currently pending claims are emphasized by italics and/or highlighting (see discussion below). No new matter has been added.

Paragraph [0016.1] recites subject matter substantially the same as original claim 6, which depends from original claim 1.

1. (Original Parent Application Claim) An e-mail method, comprising:
recognizing whether an electronic mail message is to be sent; and
alerting a system user as to the message being sent.

6. (Original Parent Application Claim) A method as recited in claim 1, ***wherein said recognizing recognizes a send operation initiated by an unauthorized agent.***

Paragraph [0016.2] recites subject matter substantially the same as original claim 13.

13. (Original Parent Application Claim) An electronic mail method, comprising:
recognizing that a message is to be sent by an unauthorized agent; and
alerting the user.

Paragraph [0016.3] recites subject matter substantially the same as original claim 14.

14. (Original Parent Application Claim) An e-mail method, comprising:
recognizing whether an electronic mail message is to be sent by a user or an unauthorized agent;
alerting the user as to the message being sent and as to addressees of the message by providing a display of both alias names and fully resolved addresses when available and a confirmation field for each address;
allowing the user to approve sending of the message to an addressee after the alert by marking the confirmation field;
allowing the user to modify an addressee list after the alert;
allowing the user to erase the message; and
sending the message after all addressees have been approved.

Paragraph [0016.4] recites substantially the same subject matter of original claim 22.

22. (Original Parent Application Claim) An electronic mail method, comprising:
determining whether an electronic mail message is to be sent by detecting a send operation initiated by the user ***or detecting a send operation initiated by an unauthorized agent;***
alerting an e-mail system user as to addressees of the message by providing a display of both available alias names and fully resolved addresses and a confirmation field for each intended recipient;
allowing the user to modify an addressee list after the alert with the alert being again produced after the intended recipient list is modified;

allowing the user to approve sending of the message after the alert; and
sending the message after approval.

Favorable consideration and entry of these formal amendments to the specification respectfully are requested.

Objection to Claim 12, 13, 28, 29 and Certain Claim Language Traversed

The 'objection' to claims 12, 13, 28, and 29, and to certain language allegedly recited in such claims, respectfully is traversed.

Initially, as agreed to by the Examiner in the telephone interview on March 23, 2009, claims 12 and 13 do not include any of the listed terms, and the language "means for ..." presented in the claims (means-plus-function format under paragraph 6 of 35 U.S.C. § 112) does not require *in haec verba* antecedent basis in the specification.

With respect to the remaining terms, Applicants submit that use of such terms in the claims are supported by the disclosure in the original application. Applicants direct the Examiner's attention to the written disclosure at page 5, lines 9-13 of the original application, wherein Applicants disclose exemplary features of a system implementing the claimed invention. Specifically, the specification states (emphasis added):

The present invention is designed to operate in an environment in which a user of an electronic mail (e-mail) system has access to a typical computer system, as depicted in Figure 1, such as a desk top *computer system including a computer which executes an e-mail client application . . . The computer also includes storage, including RAM, ROM, magnetic disk, optical disk, etc., suitable for storing and distribution of the processes and displays described herein. . .*

Those skilled in the relevant art of computers and electronic mail messaging systems readily will appreciate that such disclosure of a computer system including such *storage* clearly supports the features/claim language/terms "computer readable storage medium" and "computer-readable medium."

Finally, without conceding the propriety of the objection, claim 28 has been cancelled herein without prejudice to or disclaimer of the subject matter recited therein. Accordingly, the objection to the term "module" is rendered moot.

For the reasons discussed above and in the Examiner interview, reconsideration and withdrawal of the 'objection' respectfully are requested.

Rejection Under 35 U.S.C. 112 Traversed

The rejection of claims 1-13, 23-27, and 29 under the first paragraph of 35 U.S.C. § 112, respectfully is traversed. Nevertheless, without conceding the propriety of the rejection, the specification has been amended herein to include subject matter presented in the original claims of original/parent Application No. 09/337,035 (now U.S. Patent No. 6,671,718), which application was incorporated by reference in the present application upon filing of the present application; further, without conceding the propriety of the rejection, claims 1-13, 23-27, and 29 have been amended herein to delete language therein objected to by the Examiner in favor of language more clearly provided in the application as originally filed and/or as amended above to explicitly include the subject matter of original parent Application No. 09/337,035 previously incorporated by reference. No new matter has been added.

Applicants submit that claims 1-13, 23-27, and 29 satisfy all of the requirements of 35 U.S.C. § 112. Support for each of the independent claims may be found throughout the specification, and particularly in Fig. 1 and paragraphs [0010], [0011], [0014], [0016.1]-[0016.4], [0017], and [0024]-[0026], as discussed below (emphasis added by italics and highlighting).

Initially, the specification explicitly teaches that those skilled in the art well know that a computer virus is a process executing on a user's computer system that can compose and

send/transmit an unauthorized e-mail. The specification also explicitly states that an object/feature of the invention is to provide a system that alerts a user that such an unauthorized electronic mail message is about to be sent from a computer by such an unauthorized agent (e.g. virus), and to permit the user to stop it. For example, the specification states:

[0010] Today ***computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.***

[0011] ***What is needed is a system that will alert a user when an unauthorized e-mail is being sent by the user's system and allow the user to cancel the message before it is sent.***

SUMMARY OF THE INVENTION

...

[0014] ***It is another object of the present invention to alert a user when an unauthorized e-mail is being sent.***

...

[0017] ***These together with other objects and advantages which will be subsequently apparent, reside in the details of construction and operation as more fully hereinafter described and claimed,*** reference being had to the accompanying drawings forming a part hereof, wherein like numerals refer to like parts throughout.

As disclosed in the above paragraphs, the specification explicitly identifies as an object and feature of the invention to provide an alert when an unauthorized e-mail, e.g., composed by a computer virus (i.e., a *process* executing on the user's system), is about to be sent from the computer.

The subject matter recited in original claims 1/6, 13, 14 and 22 of original parent Application No. 09/337,035, added by formal amendment to the specification herein as paragraphs [0016.1]-[0016.4], further explains features of such an unauthorized e-mail

message composed and sent by an unauthorized agent, such as a virus process executing on the user's computer.

[0016.1] In one aspect, the present application relates to an e-mail method comprising **recognizing whether an electronic mail message is to be sent** and alerting a system user as to the message being sent, **wherein the recognizing process recognizes a send operation initiated by an unauthorized agent**.

[0016.2] In another aspect, the present application relates to an electronic mail method comprising **recognizing that a message is to be sent by an unauthorized agent**, and alerting the user.

[0016.3] In another aspect, the present application relates to an e-mail method comprising **recognizing whether an electronic mail message is to be sent by a user or an unauthorized agent**, and alerting the user as to the message being sent. The method may include alerting the user as to addressees of the message by providing a display of both alias names and fully resolved addresses when available, and a confirmation field for each address, allowing the user to approve sending of the message to an addressee after the alert by marking the confirmation field, allowing the user to modify an addressee list after the alert, **allowing the user to erase the message**, or sending the message after all addressees have been approved.

[0016.4] In another aspect, the present application relates to an electronic mail method comprising **determining whether an electronic mail message is to be sent by** detecting a send operation initiated by the user or **detecting a send operation initiated by an unauthorized agent**, and alerting an e-mail system user as to addressees of the message by providing a display of both available alias names and fully resolved addresses and a confirmation field for each intended recipient. The method further may include allowing the user to modify an addressee list after the alert with the alert being again produced after the intended recipient list is modified, allowing the user to approve sending of the message after the alert, or sending the message after approval.

The specification provides further disclosure tying these features together and evidencing that the inventors had possession of the subject matter recited in the claims at the time the application was filed. And the specification describes structure for carrying out the claimed invention.

[0024] The present invention is directed to a system that includes an electronic mail (e-mail) alert system which reduces the possibility of inadvertently sending an e-mail message to an unintended recipient and **allows the user to intercept and stop unauthorized e-mail from being sent by the user's computer**. The present invention modifies the operation of a conventional e-mail system (or computer-user to computer user or other network communication device to computer-user messaging system or other network communication device) to **alert the user before messages are sent and allow the user to change the recipients or cancel the message**.

[0025] The present invention is designed to operate in an environment in which a user of an electronic mail (e-mail) system has access to a typical computer system 10, **as depicted in Figure 1, such as a computer system including a computer 12 which executes an e-mail client application**, a display 14 on which e-mail messages are viewed in application windows, a keyboard 16 used to compose e-mail messages and an input device 18, such as a mouse, used to activate controls (buttons) in the e-mail system. The computer 12 includes a modem or network interface that allows the computer to connect to a transmission network 20, such as a corporate or enterprise network, the Internet or any other computer or communications network, allowing the user to send messages to and receive messages from other computers 22 and 24 (or other network communications devices) connected to the network. The computer also includes **storage, such as RAM, ROM, magnetic disk, optical disk, etc., suitable for storing and distribution of the processes and displays described herein**. The invention can also be distributed via downloading over a network or otherwise.

[0026] When a user has composed a message and requested that the message be sent) for example, by activating a send control -button - on the e-mail application's graphical user interface (GUI) displayed on the display 14 by the e-mail program executing in the computer 12), **or an unauthorized message is about to be sent, the present invention alerts the user by popping-up or displaying a dialog box 30, such as depicted in Figure 2, or activating another type of alert** such as an icon, sound, verbal cue, etc. The alert need not be limited to the type shown in Figure 2, which is offered an [sic] example only. The dialog box 30 includes text 32 which indicates to the user that the user is about to send a message to the listed individuals.

Thus, each of independent claims 1, 6, 7, 9, 10, 11, 12, 13, 23, 26, 27, and 29 recites subject matter that is described in the specification in a manner such that those skilled in the art readily would appreciate that the inventors had possession of the claimed subject matter at the time the application was filed.

Request for Entry of Amendment and Reply Under 37 C.F.R. § 1.116

Applicants respectfully request that the present Amendment and Reply be entered and considered under 37 C.F.R. § 1.116. Applicants believe that the finality of the present Office Action is premature in view of the prosecution history, and further submit that the present amendments merely are minor or formal in nature, will not require substantial or undue further consideration, and place the application in condition for allowance and/or present the claims in better form for appeal.

The present Office Action presents the first examination on the merits of the claims subsequent to the Decision on Appeal, dated March 27, 2007, in the present application. In particular, the Office Action is the first examination on the merits for at least claims 23-29 of the present application. Importantly, no art has been cited or applied against the claims since the Board Decision on Appeal.

In the Decision on Appeal, the Board of Patent Appeals and Interferences ("the Board") reversed the Examiner's rejection of the claims on appeal. Specifically, the Board reversed the rejection of claims 1-13 over the cited U.S. Patent No. 6,073,133 (Chrabaszcz) and U.S. Patent No. 6,434,601 (Rollins). The Board also determined that the Examiner's 'objection' to claims 1-13 under 35 U.S.C. § 132, as introducing new matter, was *improper*. The Board *sua sponte* entered a new rejection of claims 1-13 under the first paragraph of 35 U.S.C. § 112, for reciting a negative limitation feature - "not created by a user" - that allegedly is not supported by the original disclosure.

In response to the Decision on Appeal, on May 29, 2007, Applicants filed an Amendment and Reply, amending claims 1-13 to delete the negative limitation identified by the Board as allegedly not supported by the specification ("not created by a user") in favor of

features recited in a positive manner. For example, independent claim 1 was amended to recite the feature "created by an unauthorized process." The Amendment also included new claims 14-22 for consideration.

Applicants received an Office Action/Communication mailed September 25, 2007, indicating that the May 29 Amendment and Reply was non-compliant, because it did not identify support in the specification for the amended claims.

In response to the Office Action/Communication, on March 25, 2008, Applicants filed a further Amendment and Reply identifying support for the amended claims and providing remarks regarding the relationship between the newly presented claims and the prior pending claims, as requested by the Examiner and discussed in a telephone communication on December 28, 2007.

Applicants then received an Office Action mailed July 22, 2008, entering a Restriction Requirement (identifying three allegedly distinct inventions: Group I, claims 1-13; Group II, claims 14, 21 and 22; and Group III, 15-20), and objecting to the March 25 Amendment under 35 U.S.C. § 132, as allegedly adding new matter.

In response to the Office Action, on October 22, 2008, Applicants filed a further Amendment and Reply traversing the Restriction Requirement and provisionally electing Group I (claims 1-13 and new claims 23-29) for examination on the merits in the present application. Applicants also traversed the 'objection' to the prior Amendment under 35 U.S.C. § 132 as clearly improper, in accordance with the specific determination and instructions by the Board in the Decision on Appeal in this application.

The current Office Action, mailed October February 5, 2009, rejects all elected claims 1-13 and 23-29 under the first paragraph of 35 U.S.C. 112, as allegedly reciting subject

matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In the present Amendment and Reply, Applicants have (1) amended the specification to explicitly include subject matter from original/parent Application No. 09/337,035 previously incorporated by reference, (2) amended certain independent claims to recite language supported *in haec verba* in the original specification and claims of the present application and original/parent Application No. 09/337,035, (3) amended the claims to delete language objected to by the Examiner, and (4) presented arguments demonstrating that the claimed subject matter is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants further have cancelled independent claim 28 and all claims previously withdrawn from consideration pursuant to the restriction requirement (claims 14-22). Accordingly, Applicants submit that the present Amendment and Reply obviates the formal rejection of claims 1-13, 23-27, and 29; also, since the Board reversed the Examiner's prior rejections of the claims over the art and the Examiner has not cited any new art or made any new rejection of the claims over the art, Applicants submit that the amendments place the claims in condition for allowance and/or place the claims in better form for appeal.

For the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the finality of the Office Action, and/or alternatively enter and consider the present Amendment and Reply under 37 C.F.R. § 1.116.

Conclusion

Applicants believe that the present Amendment and Reply is responsive to each of the points raised by the Examiner in the Office Action and the telephone interview, and submits that the application and claims are in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Christopher Philip Wrist
Attorney for Applicants
Registration No. 32,078

Date: April 29, 2009

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

959082_1.DOC